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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,996	10/17/2001	Hidetaka Anma	Q66764	4505
7590 03/22/2004 SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue, N.W. Washington, DC 20037-3202			EXAMINER NEGRON, ISMAEL	
			ART UNIT 2875	PAPER NUMBER

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/977,996

**Applicant(s)**

ANMA ET AL.

**Examiner**

Ismael Negron

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment filed on December 30, 2003 has been entered. Claims 1, 6, 7 and 10 have been amended. Claim 5 has been cancelled. No claims have been added. Claims 1-4 and 6-10 are still pending in this application, with claim 1 being independent.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 and 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over AIKAWA et al. (U.S. pat. 6,435,702) in view of TEMME et al. (U.S. Pat. 6,934,635) and WILLEMS et al. (U.S. Pat. 6,194,497).

AIKAWA et al. discloses a vehicle headlamp having:

- **a light source**, Figure 1, reference number 18;
- **a lamp body**, Figure 1, reference number 10;
- **the lamp body having a front opening**, inherent;
- **a front lens covering the front opening of the lamp body**,  
Figure 1, reference number 12;

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- **a main reflective surface**, Figure 1, reference number 16;
- **a extension reflector**, Figure 1, reference number 24;
- **the extension reflector being operable to reflect light from the light source**, inherent;
- **a front end portion of the extension reflector being disposed in proximity to the front lens**, column 3, lines 52-54;
- **the extension reflector being provided with a metal film**, inherent; and
- **the extension reflector being formed separate from the main reflective surface**, Figure 1.

AIKAWA et al. teaches all the limitations of the claims, except the extension reflector being made integrally with the main reflective surface, the front lens having an anti-static agent formed within the base material, and such front lens having an initial surface resistance of  $10^{13} \Omega/\text{cm}^2$  or less, or the anti-static agent being 2% wt of the base material of the front lens..

TEMME et al. discloses a vehicle headlamp having:

- **a front lens**, Figure 1, reference number 3;
- **the front lens having a base material**, column 2, lines 36-39;
- **the front lens also having an anti-static material coating on the base material**, Figure 1, reference number 4;
- **the anti-static material being a surface-active agent**, Figure 1;
- **a light source**, Figure 1, reference number 2;

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- **a lamp body**, Figure 1, reference number 1;
- **the lamp body having a front opening**, Figure 1; and
- **the front opening being covered by the front lens**, Figure 1.

WILLEMS et al. discloses an anti-static resin composition.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the resin composition of WILLEMS et al. as the material of the front lens of AIKAWA et al. to obtain a front lens with increased anti-static effectiveness to reduce, or even eliminate, the problems associated with the static attraction of particles (e.g. dust) which can decrease the efficiency of the headlamp, as evidenced by TEMME et al. (column , lines ) and WILLEMS et al. (column 1, lines 17-50).

Regarding the extension reflector being made integrally with the main reflective surface, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the extension reflector integrally made with the main reflective surface, since it has been held that forming in one piece an article which has previously been formed in a plurality of pieces and then put together, involve only routine skill in the art and it is devoid of an inventive step. See *Howard v. Detroit Stove Works*, 150 USPQ 164 (1863).

In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to obtain the claimed front lens initial surface resistance of  $10^{13} \Omega/\text{cm}^2$  or lower, or making the antistatic agent 2% wt of the base material of the front lens, since it has been held that discovering an optimum value of a result effective

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variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In this case, the use of anti-static coatings to increase conductivity of a base material to prevent the accumulation of contaminants due to static charging, is old and well known in the art (as evidenced by both TEMME et al. and WILLEMS et al.). Determining the optimal values of the required conductivity to obtain minimum accumulation, and the amount of material needed to be added to the base material, was considered a result of due experimentation.

Even further, it is noted that while the specification, as filed, states that the claimed 2% wt is sufficient to obtain the necessary conductivity range, the conductivity range is a function of both the composition and nature of the anti-static agent, and the amount of agent used.

### ***Response to Arguments***

Applicant's arguments filed December 30, 2003 have been fully considered but they are not persuasive.

3. Regarding the Examiner's rejection of claims 1 and 5 under 35 U.S.C. 103(a) as unpatentable over AIKAWA et al. in view of WILLEMS et al., the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically a vehicle lamp wherein "tree marks" (static marks) cannot be formed on the inner surface of the front lens.

Applicant further argues that AIKAWA et al. is silent as to the specific problems addressed by the claimed invention, and implies that improper hindsight was used in the Examiner's reconstruction of the claimed invention.

4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., prevention of "tree marks" being formed on the surface of the lens) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). However, even if such "tree marks" prevention feature was positively recited in the claim the cited combination of references would still read on the claims. While the applicant is allowed to act as his or her own lexicographer, the terms with which the claims (and the specification) define certain phenomena does not provide basis for patentability. If the Prior Art is able to provide the same effect as the claimed invention then the claims are unpatentable, even if the terminology used by the Prior Art is different from the one used by the applicant.

In this case, WILLEMS et al. provides an anti-static polymer composition, as claimed, and even testifies to the advantages of such composition for reducing, or even eliminating, the accumulation of contaminants that would otherwise reduce the transparency of certain polymers (see column 1, lines 15-22). Given the fact that contamination of vehicle lamp lens is a old and well known problem in the illumination art, as evidenced (inter alia) by TEMME et al., using the composition of WILLEMS et al.

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as the material for the lens of AIKAWA et al. would have flown naturally to one of ordinary skill in the art.

5. In response to applicant's argument that AIKAWA et al. is silent as to the specific problems addressed by the claimed invention, the applicant is advised that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, while it might be a fact that AIKAWA et al. is silent as to the specific problem of decreased transparency associated with particle contamination of electro statically charged polymer lenses, WILLEMS et al. was specifically concerned with such problems (also note Section 6 of the previous Office Action). Using the anti-static composition of WILLEMS et al. in the polymer lens of AIKAWA et al. would have flown naturally from the combined teachings of both references.

In addition, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is, in a sense, necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As previously stated, the disclosure of WILLEMS et al. provides motivation for



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modifying the polymer lens of AIKAWA et al. to include an anti-static feature, even more so in light of the disclosure of TEMME et al..

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

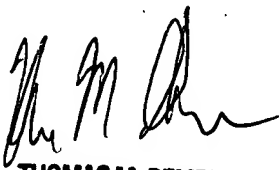
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached at (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.



**THOMAS M. SEMBER**  
**PRIMARY EXAMINER**



Inr

March 12, 2004